



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,829	02/07/2002	Mark Douglas Howell	4369-1-1	4144

7590 09/07/2005

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EXAMINER

LAM, ANN Y

ART UNIT PAPER NUMBER

1641

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/071,829

Applicant(s)

HOWELL ET AL.

Examiner

Ann Y. Lam

Art Unit

1641

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED July 19, 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

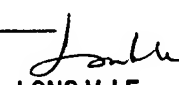
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 50,51,60-65,69-74,80 and 81.  
Claim(s) withdrawn from consideration: 52-59,66-68 and 75-79.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_

  
LONG V. LE 08/21/05  
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Continuation of 3. NOTE: Assuming that Applicant's proposed limitations is interpreted to exclude interferons from being one of the binding partner, this changes the scope of the claims and thus would require further search and consideration. (However, the Office notes that Applicant's proposed limitations can be interpreted in a different way such that the claims do not exclude interferons from being one of the binding partner, as further explained in the notes to box 11 in this Advisory action.)

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's proposed amendment do not overcome the prior art of record. Applicant argues on page 16 that the proposed amendment excludes the removal of interferon. The Office disagrees because the proposed limitation in line 11 recites "wherein binding partners.....are selected from ...." as opposed to -- wherein all binding partners....are selected from....-- In other words, because the limitation "binding partners" in line 11 is not clear as to whether all binding partners or the at least one binding partner in line 4 is being referred to, the language is open to either interpretation. In any case, if Applicant proposes limitations that exclude interferons from being one of the binding partner, this would require further search and consideration. Also, Applicant argues on page 16 that the prosecution of Skurkovich '843 supports that Skurkovich '843 is not an enabling reference against the present claims, wherein removal of interferon is excluded. This is not found to be persuasive. Applicant argues on page 15 that the examiner in the prosecution of Skurkovich '843 found the claims to not be enabled because "it is unpredictable whether the removal of a single mediator or multiple mediators will result in a significant effect" and that "a showing relating to alpha interferon could not serve as a basis for predicting that removal of gamma interferon and beta interferon would result in a similar effect". These assertions by Applicant are not persuasive because they are not relevant as to whether or not interferons must be removed in Skurkovich '843. Applicant further asserts that Skurkovich amended its claims to require the removal of interferon or its receptor. However, the Office asserts that this does not necessarily mean that the the patent is not enabling against claims wherein removal of interferon is excluded. Likewise, Applicant also argues that Skurkovich argued that it was the "combination of anti-IFN alpha and anti-IFN gamma or to either one in combination with an anti-TNF" which lent patentability to their claims. Even if Skurkovich made such statements or implications, this does not necessarily mean that the patent is not enabling against claims wherein removal of interferon is excluded. In any case, the proposed claims do not exclude the removal of interferon as explained earlier above.